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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Venkatesh KRISHNAN, et al.

Confirmation No.: 6414

Application No.: 09/770,556

Examiner: Lee, P. C.

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Group Art Unit: 2154

Title: AN INTERNET APPLIANCE REMOTE OPERATOR

Mail Stop Appeal Brief-Patents
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RESPONSE TO NON-COMPLIANT APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Non-Compliant Appeal Brief mailed on 11/06/06

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$450

☐ 3rd Month
\$1020

☐ 4th Month
\$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 0. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: Krishnan et al.

Patent Application

Serial No.: 09/770,556

Group Art Unit: 2154

Filed: January 26, 2001

Examiner: Lee, Philip C.

For: AN INTERNET APPLIANCE REMOTE OPERATOR

Amended Appeal Brief



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Real Party in Interest

The assignee of the present invention is Hewlett-Packard Company.

Related Appeals and Interferences

There are no related appeals or interferences known to the Appellant.

Status of Claims

Claims 18-34 are pending. Claims 18, 24 and 30 are rejected under 35 U.S.C. 112 first paragraph. Claims 18-22, 24-28 and 30-33 are rejected under 35 U.S.C. § 103(a). Claims 23, 29 and 34 are further rejected under 35 U.S.C. § 103(a). Rejections of claims 18-34 are herein appealed.

Status of Amendments

All proposed amendments have been entered. An amendment subsequent to the Advisory Action has not been filed.

Summary of Claimed Subject Matter

In accordance with Independent Claim 18, one embodiment of the present claimed invention pertains to a portable device for wirelessly interacting with an Internet appliance. The device comprises a receiver (item 24 of Figure 1 and page 11 lines 20-26) for wirelessly receiving a web address for an Internet audio broadcast from a first Internet appliance. The device further comprises a memory for storing (item 43 of Figure 3 and page 17 lines 9-20) the web address for the Internet audio broadcast received from the first Internet appliance. The device also comprises a transmitter (item 15 and 23 of Figure 1 and page 13

lines 5-10) for wirelessly providing the web address for the Internet audio broadcast to a second Internet appliance. The device further comprises a preference control for organizing the portable device transfer of the web address for the Internet audio broadcast to the second Internet appliance in a selected order (items 31, 32, and 38 of Figure 5 and page 19 lines 8-17).

The device further comprises a user interface (item 41 of Figure 3 and page 15 lines 1-13) to cause the transmitter or receiver to transmit or receive the web address for the Internet audio broadcast in response to a user control command received from the user interface.

Wherein the portable device is a key chain tag-sized device (item 10 of Figure 1 and page 7 lines 16-24).

The device further comprises a beacon transmitter that transmits wirelessly a beacon signal containing the web address for the Internet audio broadcast, wherein the beacon transmitter has a predetermined transmission range (item 15 and 23 of Figure 1 and page 13 lines 5-10).

The device further comprises a beacon receiver that receives an external electronic transmission containing the web address for the Internet audio broadcast, and extracts the web address for the Internet audio broadcast from the transmission (item 53 of Figure 3 and page 15 line 24 - page 16 line 4).

The device further comprises the storage is partitioned into a general storage area and a customized storage area that stores user-specified web

addresses for the Internet audio broadcast (item 43 of Figures 2 and 3 and page 18 line 22 - page 19 line 7).

In accordance with Independent Claim 24, one embodiment of the present claimed invention pertains to a portable device for wirelessly interacting with an Internet appliance. The device comprises a receiver (item 24 of Figure 1 and page 11 lines 20-26) for wirelessly receiving a web address for an Internet video broadcast from a first Internet appliance. The device also comprises a memory for storing (item 43 of Figure 3 and page 17 lines 9-20) the web address for the Internet video broadcast received from the first Internet appliance. The device further comprises a transmitter (items 15 and 23 of Figure 1 and page 7 line 24 - page 8 line 9) for wirelessly providing the web address for the Internet video broadcast to a second Internet appliance. The device also comprises a preference control for organizing the portable device transfer of the web address for the Internet video broadcast to the second Internet appliance in a selected order (items 31, 32, and 38 of Figure 5 and page 19 lines 8-17).

The device further comprises a user interface (item 41 of Figure 3 and page 15 lines 1-13) to cause the transmitter or receiver to transmit or receive the web address for the Internet video broadcast in response to a user control command received from the user interface.

Wherein the portable device is a key chain tag-sized device (item 10 of Figure 1 and page 7 lines 16-24).

The device further comprises a beacon transmitter that transmits wirelessly a beacon signal containing the web address for the Internet video broadcast, wherein the beacon transmitter has a predetermined transmission range (item 15 and 23 of Figure 1 and page 13 lines 5-10).

The device further comprises a beacon receiver that receives an external electronic transmission containing the web address for the Internet video broadcast, and extracts the web address for the Internet video broadcast from the transmission (item 53 of Figure 3 and page 15 line 24 - page 16 line 4).

The device further comprises the storage is partitioned into a general storage area and a customized storage area that stores user-specified web addresses for the Internet video broadcast (item 43 of Figures 2 and 3 and page 18 line 22 - page 19 line 7).

In accordance with Independent Claim 30, one embodiment of the present claimed invention pertains to a method for wirelessly interacting with an Internet appliance. In one embodiment, as described on page 11 lines 8-19, a web address is received from a first Internet appliance. The web address received from the first Internet appliance is stored on the portable device, wherein the portable device is a key chain tag-sized device, as described on page 7 lines 16-24. The web address is provided to a second Internet appliance, as described on page 7 lines 16-24. Then, embodiments organize the portable device transfer of the web address to the second Internet appliance in a selected order.

In one embodiment, the method comprises providing a user interface to cause the transmitter or receiver to transmit or receive the web address in response to a user control command received from the user interface, as described on page 15 lines 1-13.

In one embodiment, the method comprises utilizing a beacon transmitter that transmits wirelessly a beacon signal containing the web address, wherein the beacon transmitter has a predetermined transmission range, as described on page 13 lines 5-10.

In one embodiment, the method comprises utilizing a beacon receiver that receives an external electronic transmission containing the web address, and extracts the web address from the transmission, as described on page 15 line 24 - page 16 line 4.

In one embodiment, the method comprises partitioning the storage into a general storage area and a customized storage area that stores a user-specified web address, as described on page 18 line 22 - page 19 line 7.

Grounds of Rejection to be Reviewed on Appeal

The amendment filed August 11, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure.

Claims 18, 24 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Claims 18-22, 24-28 and 30-33 under 35 USC 103(a) as being unpatentable over Weiser et al. (5982520) in view of Utsumi (6243741).

Claims 23, 29 and 34 under 35 USC 103(a) as being unpatentable over Weiser et al. and Utsumi in view of Wiener et al. (6701317).

Grouping of Claims

For each ground of rejection that applies to more than one claim, the claims do not stand or fall together. For purposes of appeal, the claims are grouped as follows:

Group 1: Claims 18, 24 and 30

Group 2: Claims 18-22, 24-28 and 30-33

Group 3: Claims 23, 29 and 34

Arguments

A. Grouping of Claims

The claims of Group 2 are considered separately patentable. The claims of Group 2 are each dependent on independent Claims 18, 24 and 30, and each claim in Group 2 recites an additional limitation that, with the limitations of Claim 18, 24 and 30, are patentably distinguishable over the cited art. In addition, the rejections of the claims of Group 2 require additional art over the reasons cited against the base claims in Group 1.

The claims of Group 3 are considered separately patentable. The claims of Group 3 are rejected based upon art that is in addition to art cited against the claims of Group 1.

B. Scope and Content of the Cited Prior Art References (Weiser et al., Utsumi, Wiener et al.)

Weiser is relied upon to teach a receiver for wirelessly receiving digital information from a first internet appliance (col.4 lines 20-22, 57-60; col. 5, lines 15-25); a memory for automatically storing said digital information received from said first Internet appliance (col. 5, lines 19-25); and a transmitter for wirelessly providing said digital information to a second Internet appliance (col. 4, lines 20-22, 57-60; col. 5 lines 15-25).

Utsumi is relied upon to teach a transmitting a web address (URL) for Internet broadcast television program (col. 5, lines 52-55; col. 7, lines 22-42). Utsumi is further relied upon to teach a preference control for organizing said

portable device transfer of said web address for said Internet broadcast television program (comprised both audio and video broadcast) to said second Internet appliance in a selected order (col. 7, lines 37-42, 50-52).

Wiener is relied upon to teach wherein the storage is partitioned into a general storage area and a customized storage area that stores user-specified web addresses (col. 8, lines 47-Col. 9, lines 5).

C. Objection of Amendment filed August 11, 2004 under 35 U.S.C. 132 because it introduces new matter into the disclosure.

The following arguments apply to the claims of Group 1, Claims 18, 24 and 30.

Claims 18, 24 and 30 recite the feature "a memory for storing said web address" which is well supported in the Figures, e.g., Figure 3 storage component 43 and throughout the specification including paragraph page 17 lines 9-20. Therefore, the objection with respect to a memory for storing is overcome.

Claims 18, 24 and 30 also recite the feature "a preference control for organizing said portable device transfer of said web address to said second Internet appliance in a selected order", Appellant respectfully points out that the feature "a preference control for organizing said portable device transfer of said web address to said second Internet appliance in a selected order" is well supported in the Figures, e.g., Figure 5 control button 38 and throughout the specification including the following paragraphs:

(page 19 lines 8-17) The other function of the control button 38 is referred to as "tag me" function which is basically a bookmark function. This function allows the remote operator 10 to tag a web address and to send the tagged web address when needed. This button allows the user of the remote operator 10 to select personalized web addresses and store them separately in the customized storage area of the storage 43. The CUSTOMIZED button 38, when pressed, normally causes the first

function to be performed. When the user of the remote operator 10 wants to use the button 38 for the second function, the user can press the button down for a predetermined period of time (e.g., five seconds). This will cause the button to be switched to the second functional mode.

(page 20 lines 6-14) In another embodiment, the UP and DOWN control buttons 31-32 can be programmed to move the web addresses stored in the storage 43 to the top or bottom entry of the storage 43. In addition, the UP and DOWN buttons 31-32 can also be used to move the personalized or book-marked web addresses in and out of the special storage entry (i.e., the "ME" storage entry) in the customized storage area of the storage 43. That "ME" storage entry stores the personalized web address to be sent to external Internet appliance. This transmission is activated or triggered by the user pressing the CUSTOMIZED button 38.

Therefore, Appellant respectfully states that the feature "a preference control for organizing said portable device transfer of said web address to said second Internet appliance in a selected order" is well supported throughout the disclosure.

For this reason, Appellant respectfully asserts that the basis for objecting to Claims 18, 24 and 30 under 35 USC 132 is overcome.

D. Rejection of Claims 18, 24 and 30 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, that the specification fails to teach a memory for automatically storing said web address and a preference control for organizing said portable device transfer of said web address to said second Internet appliance in a selected order.

The following arguments apply to the claims of Group 1, Claims 18, 24 and 30.

Claims 18, 24 and 30 recite the feature “a memory for storing said web address” which is well supported in the Figures, e.g., Figure 3 storage component 43 and throughout the specification including paragraph page 17 lines 9-20. Therefore, the objection with respect to a memory for storing is overcome.

Claims 18, 24 and 30 also recite the feature “a preference control for organizing said portable device transfer of said web address to said second Internet appliance in a selected order”, Appellant respectfully points out that the feature “a preference control for organizing said portable device transfer of said web address to said second Internet appliance in a selected order” is well supported in the Figures, e.g., Figure 5 control button 38 and throughout the specification including the following paragraphs:

(page 19 lines 8-17) The other function of the control button 38 is referred to as “tag me” function which is basically a bookmark function. This function allows the remote operator 10 to tag a web address and to send the tagged web address when needed. This button allows the user

of the remote operator 10 to select personalized web addresses and store them separately in the customized storage area of the storage 43. The CUSTOMIZED button 38, when pressed, normally causes the first function to be performed. When the user of the remote operator 10 wants to use the button 38 for the second function, the user can press the button down for a predetermined period of time (e.g., five seconds). This will cause the button to be switched to the second functional mode.

(page 20 lines 6-14) In another embodiment, the UP and DOWN control buttons 31-32 can be programmed to move the web addresses stored in the storage 43 to the top or bottom entry of the storage 43. In addition, the UP and DOWN buttons 31-32 can also be used to move the personalized or book-marked web addresses in and out of the special storage entry (i.e., the "ME" storage entry) in the customized storage area of the storage 43. That "ME" storage entry stores the personalized web address to be sent to external Internet appliance. This transmission is activated or triggered by the user pressing the CUSTOMIZED button 38.

Therefore, Appellant respectfully states that the feature "a preference control for organizing said portable device transfer of said web address to said second Internet appliance in a selected order" is well supported throughout the disclosure.

For this reason, Appellant respectfully asserts that the basis for rejecting Claims 18, 24 and 30 under 35 USC 112, first paragraph, is overcome.

E. Rejection of Claims 18-22, 24-28 and 30-33 under 35 U.S.C. § 103(a) as unpatentable over Weiser et al. (5,982,520) in view of Utsumi (US 6,243,741)

The following arguments apply to the claims of Group 2, Claims 18-22, 24-28 and 30-33.

Independent Claims 18, 24 and 30 (Group 2) recite features including “wirelessly receive a web address from a first Internet appliance, store the web address on the portable device, and provide the web address to a second Internet appliance.”

With respect to Weiser et al., as the Examiner has stated, Weiser et al. does not teach the types of digital information as Claimed in the present Application. Further, Appellant understands Weiser et al. to teach a device that can run applications, etc. In other words, Appellant understands Weiser et al. to actually teach away from a device that does not provide a broad range of programmable functions. That is, Appellant understands Weiser et al. to teach that such a limited device comes at a price.

With respect to Utsumi, Appellant respectfully disagrees that Utsumi overcomes the shortcomings of Weiser et al. Applicant understands Utsumi to teach a remote commander (or remote control) for use as an input to a web based television application. That is, Applicant understands the remote commander of Utsumi to operate as a transmitter in the same manner as a standard remote control device. Applicant does not understand the remote commander of Utsumi to provide any reception capabilities either wired or

wireless. Applicant understands Utsumi to provide only the standard manual keypad type input capabilities. Consequently, Utsumi does not overcome the deficiencies of Weiser et al., and neither Weiser et al. nor Utsumi, alone or in combination, teach, disclose or suggest the limitations of Claims 17, 21 and 28.

For this reason, Appellant respectfully asserts that the basis for rejecting Claims 18, 24 and 30 (Group 2) under 35 U.S.C. § 103(a) is overcome.

In addition, Appellant respectfully asserts that one of ordinary skill in the art would find no motivation to combine Utsumi, teaching a remote control for a web based TV application with extremely limited capabilities and no application running capability, with McClure, which teaches a device that can run applications, etc.

For this additional reason, Appellant respectfully asserts that the basis for rejecting Claims 18, 24 and 30 (Group 2) under 35 U.S.C. § 103(a) is overcome.

Further, Appellant respectfully asserts that the suggested modification of Weiser et al. in view of Utsumi would change the principle of operation of Weiser et al. As discussed previously, Weiser et al. has an extensive discussion teaching away from devices that do not provide a broad range of programmable functions.

For this yet additional reason, Appellant respectfully asserts that the basis for rejecting Claims 18, 24 and 30 (Group 2) under 35 U.S.C. § 103(a) is overcome.

To summarize, Claims 18, 24 and 30 (Group 2) recite features including “wirelessly receive a web address from a first Internet appliance, store the web address on the portable device, and provide the web address to a second Internet appliance.” Neither reference, Weiser et al. nor Utsumi, alone or in combination, teaches this element. Additionally, there is no motivation to combine Weiser et al. and Utsumi as suggested. Further still, the proposed modification of Weiser et al. in view of Utsumi would fundamentally change the principle of operation of Weiser et al. As such, Appellant respectfully submits that the basis for rejecting Claims 18, 24 and 30 (Group 2) under 35 U.S.C. § 103(a) is overcome.

Claims 19 – 22 (Group 2) depend from Claim 18 (Group 2). Appellant respectfully submits that the basis for rejecting Claims 19 – 22 under 35 U.S.C. § 103(a) is overcome as these claims depend from an allowable base claim.

Claims 25-28 (Group 2) depend from Claim 24 (Group 2). Appellant respectfully submits that the basis for rejecting Claims 25-28 under 35 U.S.C. § 103(a) is overcome as these claims depend from an allowable base claim.

Claims 31-33 (Group 3) depend from Claim 30 (Group 2). Appellant respectfully submits that the basis for rejecting Claims 31-33 under 35 U.S.C. § 103(a) is overcome as these claims depend from an allowable base claim.

F. Rejection of Claims 23, 29 and 34 under 35 U.S.C. § 103(a) as unpatentable over Weiser et al. and Utsumi in view of Wiener et al. (6,701,317)

The following arguments apply to the claims of Group 3, Claims 23, 29 and 34.

Claim 23 (Group 3) depends from Claim 18 (Group 2). Appellant respectfully submits that the basis for rejecting Claim 23 under 35 U.S.C. § 103(a) is overcome as this claim depends from an allowable base claim.

Claim 29 (Group 3) depends from Claim 24 (Group 2). Appellant respectfully submits that the basis for rejecting Claim 29 under 35 U.S.C. § 103(a) is overcome as this claim depends from an allowable base claim.

Claim 34 (Group 3) depends from Claim 30 (Group 2). Appellant respectfully submits that the basis for rejecting Claim 34 under 35 U.S.C. § 103(a) is overcome as this claim depends from an allowable base claim.

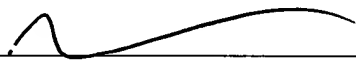
Conclusion

Appellant believes that pending Claims 18-34 are patentable over the cited art. Appellant respectfully requests that the rejection of these claims be reversed.

Respectfully submitted,

WAGNER, MURABITO & HAO LLP

Date: 11/22/06



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Appendix - Clean Copy of Claims

1-17 (canceled)

18. (previously presented) A portable device for wirelessly interacting with an Internet appliance, said device comprising:

a receiver for wirelessly receiving a web address for an Internet audio broadcast from a first Internet appliance;

a memory for storing said web address for said Internet audio broadcast received from said first Internet appliance;

a transmitter for wirelessly providing said web address for said Internet audio broadcast to a second Internet appliance; and

a preference control for organizing said portable device transfer of said web address for said Internet audio broadcast to said second Internet appliance in a selected order.

19. (previously presented) The device of claim 18, further comprising:

a user interface to cause the transmitter or receiver to transmit or receive the web address for said Internet audio broadcast in response to a user control command received from the user interface.

20. (previously presented) The device of claim 18, wherein said portable device is a key chain tag-sized device.

21. (previously presented) The device of claim 18, wherein the transmitter further comprises:

a beacon transmitter that transmits wirelessly a beacon signal containing the web address for said Internet audio broadcast, wherein the beacon transmitter has a predetermined transmission range.

22. (previously presented) The device of claim 18, wherein the receiver further comprises:

a beacon receiver that receives an external electronic transmission containing the web address for said Internet audio broadcast, and extracts the web address for said Internet audio broadcast from the transmission.

23. (previously presented) The device of claim 18, wherein the storage is partitioned into a general storage area and a customized storage area that stores user-specified web addresses for said Internet audio broadcast.

24. (previously presented) A portable device for wirelessly interacting with an Internet appliance, said device comprising:

a receiver for wirelessly receiving a web address for an Internet video broadcast from a first Internet appliance;

a memory for storing said web address for said Internet video broadcast received from said first Internet appliance;

a transmitter for wirelessly providing said web address for said Internet video broadcast to a second Internet appliance; and

a preference control for organizing said portable device transfer of said web address for said Internet video broadcast to said second Internet appliance in a selected order.

25. (previously presented) The device of claim 24, further comprising:
a user interface to cause the transmitter or receiver to transmit or receive the web address for said Internet video broadcast in response to a user control command received from the user interface.

26. (previously presented) The device of claim 24, wherein said portable device is a key chain tag-sized device.

27. (previously presented) The device of claim 24, wherein the transmitter further comprises:

a beacon transmitter that transmits wirelessly a beacon signal containing the web address for said Internet video broadcast, wherein the beacon transmitter has a predetermined transmission range.

28. (previously presented) The device of claim 24, wherein the receiver further comprises:

a beacon receiver that receives an external electronic transmission containing the web address for said Internet video broadcast, and extracts the web address for said Internet video broadcast from the transmission.

29. (previously presented) The device of claim 24, wherein the storage is partitioned into a general storage area and a customized storage area that stores user-specified web addresses for said Internet video broadcast.

30. (previously presented) A method for wirelessly interacting with an Internet appliance comprising:

receiving a web address from a first Internet appliance;
storing said web address received from said first Internet appliance on said portable device, wherein said portable device is a key chain tag-sized device;
providing said web address to a second Internet appliance; and
organizing said portable device transfer of said web address to said second Internet appliance in a selected order.

31. (previously presented) The method of claim 30, further comprising:
providing a user interface to cause the transmitter or receiver to transmit or receive the web address in response to a user control command received from the user interface.

32. (previously presented) The method of claim 30, wherein the transmitter further comprises:
utilizing a beacon transmitter that transmits wirelessly a beacon signal containing the web address, wherein the beacon transmitter has a predetermined transmission range.

33. (previously presented) The method of claim 30 wherein the receiver further comprises:
utilizing a beacon receiver that receives an external electronic transmission containing the web address, and extracts the web address from the transmission.

34. (previously presented) The method of claim 30 further comprising:

partitioning the storage into a general storage area and a customized storage area that stores a user-specified web address.

Evidence Appendix

None

Related Proceedings Appendix

None